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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,943	03/24/2004	Maria Theresa Barnes-Leon	OIC0101US	6435
60975 7590 09/24/2007 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758			EXAMINER CORRIELUS, JEAN M	
			ART UNIT 2162	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/809,943

Applicant(s)

BARNES-LEON ET AL.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on June 21, 2007, in which claims 2-45 are presented for further examination.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 2-45 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

3. Claims 2 and 24 are objected to because of the following informalities: Claims 2 and 45 recite "extracting enterprise information in a first form" and "extracting enterprise information in a third form". It is unclear one having ordinary skill in the art would extracting enterprise information in a third form without, first, extracting information in a second form

The clause "adapted to" in claims 2 and 24 does not require steps to be performed and does not limit a claim to a particular structure does not limit the scope of the claims or claim limitation. In other words, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Therefore, the clause "adapted to" is not given weight when it simply expresses the intended result of a process step positively recited. Furthermore, the examiner has given the claims their broadest reasonable interpretation in light of the supporting disclosure. It is advised to amend the claims to better reflect what applicant intends to claim as

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the invention. Applicant is reminded that claims and disclosures are not to be evaluated in a vacuum.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2-45 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2 and 24 recite “converting the enterprise information in the third form into second corresponding information wherein the second corresponding information is in the intermediate form; and converting the enterprise second corresponding information into second enterprise information, wherein the second enterprise information is in the target form”. It appears that the claims do not provide a concrete result to form the basis statutory under 35 USC 101. Applicant should duly note that converting the enterprise information is just a transformation of that data from one state to another state. Such conversion of enterprise information from a third form into second correspondence information without providing a useful result is not statutory.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of the claimed is structured in a confusing manner. It is unclear how one having ordinary skill in the art would convert the enterprise information in a first form into first corresponding information and then converting the first corresponding information into the first enterprise information. Secondly, the claims recite that the first enterprise information is in a target form and the target form corresponds to a target computerized system, and wherein the second enterprise information is in the target form. It is not clear how one having ordinary skill in the art would have both the first and second enterprise information are in the target form. Therefore, for the purpose of examination, the examiner has considered there is no distinction between the first and second. Clarification of such language is strongly advised.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. In particular, the claimed feature of “converting the enterprise corresponding information in the intermediate form into first enterprise information a target form that corresponds to a target computerized system, wherein the first enterprise information is in a target form the target form corresponds to a target computerized system the intermediate form includes comprises a plurality of common data type elements, and the common data type elements are adapted to be shared across a plurality of data objects in the intermediate form; extracting enterprise information in a third form wherein the third form is associated with a second source computerized system, and the second source computerized system is distinct from the first source computerized system; converting the enterprise information in the third form into enterprise second corresponding information wherein the second corresponding information is in the intermediate form; and converting the enterprise second corresponding information the intermediate form into second enterprise information wherein the second enterprise information is in the target form” are not described in the specification to enable one having ordinary skill in the art to make and use the invention. The specification paragraph [0036] converts enterprise information in the first source format, the facility converts enterprise information by converting the enterprise information that is in the first source; and [0039] converts some or all the enterprise information that is in the source format into the target format by using an intermediate format of the enterprise information. However, such abovementioned of the specification does not *extract enterprise information in a third form wherein the third form is associated with a second source computerized system, and the second source computerized system is distinct from the first source computerized system; converting the enterprise information in the third form into enterprise second corresponding information wherein the*

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*second corresponding information is in the intermediate form; and converting the enterprise second corresponding information the intermediate form into second enterprise information wherein the second enterprise information is in the target form.* Based on the analysis provided above and substantial evidence or reasoning, the examiner provided that one having ordinary skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. The limitation as claimed *“extracting enterprise information in a third form wherein the third form is associated with a second source computerized system, and the second source computerized system is distinct from the first source computerized system; converting the enterprise information in the third form into enterprise second corresponding information wherein the second corresponding information is in the intermediate form; and converting the enterprise second corresponding information the intermediate form into second enterprise information wherein the second enterprise information is in the target form”*; are not supported by the as-filed disclosure, which is violated the written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). Applicant should duly note that the first paragraph of 35 U.S.C. 112 requires that the “specification shall contain a written description of the invention”. Applicant should also note that the essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed; and to put the public in possession of what the applicant claims as the invention.” Furthermore, the written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Indeed, the specification doe not

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satisfy the written description requirement because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 24 as best understood by the examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouziane et al., (hereinafter "Bouziane") US Patent no. 5,727,158 and Inohara et al., (hereinafter "Inohara") US Patent No. 6,377,952.

As to claim 2 and 24, Bouziane is directed to information repositories for storing and facilitating the retrieval of large amount of data for access by a variety of computing tools in an enterprise-computing environment. In particular, Bouziane discloses "extracting enterprise information associated with a first source computerized system" (col.1, lines 48-52; col.2, lines 7-10); "converting the enterprise information in an intermediate form" (col.11, lines 11-14). However, Bouziane does not explicitly disclose the enterprise information in the intermediate form into a target form. Inohara discloses an analogous system for translating enterprise information in the intermediate form into a target form (col.4, lines 60-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the enterprise computing system as disclosed by Bouziane would



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incorporate the use of converting enterprise information in the intermediate form into a target form, in the same conventional manner as disclosed by Inahara. One having ordinary skill in the art would have found it motivated to use such a combination for the purpose of performing only the essential works of a various format conversions without involving the user in the format conversion.

As to claim 24:

Claim 24 is computer programs for performing the method of claims 2. It is, therefore, rejected under the same rationale

12. Claims 3-23 and 25-45 as best understood by the examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouziane et al., (hereinafter "Bouziane") US Patent no. 5,727,158 and Inohara et al., (hereinafter "Inohara") US Patent No. 6,377,952 and further in view of Guyan et al., (hereinafter "Guyan") US patent no. 7,124,112

As to claim 3, Bouziane and Inohara substantially disclose the invention as claimed. Neither Bouziane nor Inohara discloses a payment card type element. On the other hand, Guyan discloses the claimed "payment card type element" (see col.11, lines 24-31, type of payment). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made combine the teachings of the cited references, wherein the enterprise computing system as disclosed by Bouziane would incorporate the use of a payment card type element, in the same conventional manner as disclosed by Guyan see col.11, lines 24-31. One having ordinary skill in

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the art would have found it motivated to use such a combination in order to maintain a good relationship between the claimants and the enterprise computerized system.

As to claim 4 Bouziane discloses the claimed “an application instance name element” (col.1, lines 48-52, information exchange which translate data between models formats of various programs).

As to claims 5 and 7, Guyan discloses the claimed “an error type element” (col.1, lines 59-61, claim processing arenas).

As to claims 6, 8 and 17, Guyan discloses the claimed “message text element” (col.11, lines 65-67; col.14, lines 27-41, displays claimant level information)

As to claims 9-12, Guyan discloses the claimed “cross reference ID’ (col.10, lines 63-65, cross reference ID sub-element).

As to claims 13-14, Guyan discloses the claimed “a message code sub-element” (col.9, lines ICD-9 code indicating the treatment and other medical details).

As to claims 15-16, Guyan discloses the claimed “value cross reference elements” (col.10, lines 36-65, cross reference type and level data with the vendor database and queries for a listing authorized vendors).

As to claim 18, Guyan discloses the claimed “activity duration (end date) element” col.12, lines 15-20, maximum days allowed after the claims is closed).

As to claim 19, Guyan discloses the claimed “address line elements” col.12, lines 59-61, address line).

As to claims 20-22, Guyan discloses the claimed “a Id element, email element” (col.12, lines 59-61, email element).

As to claim 23, Guyan discloses the claimed “payment card type element” (col.11, lines 20-30, payment process).

As to claims 25-45:

Claims 25-45 are computer programs for performing the method of claims 3-23. They are, therefore, rejected under the same rationale.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Jean M Corrielus  
Primary Examiner  
Art Unit 2162

September 17, 2007